

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U. S. C. 121:
 - I. Claims 1-15, drawn to a fluorogenic composition for the detection of the activity of a protease having the formula cited in claim 1, classified in class 514, subclass 13, and class 549, subclass 227.
 - II. Claims 16-26, drawn to a method of detecting the activity of a protease, comprising contacting the protease with the composition in a cell culture or a tissue sample, classified in class 514, subclass 13, and class 549, subclass 227.

Should group I or II be elected, applicant is required to select one amino acid sequence identified with a "SEQ ID NO:" which has a defined amino acid residue at each position. Applicant is also required to select a fluorophore and a hydrophobic group. Any change of amino acid residue at any one or more positions in the sequence is considered, absent factual data to the contrary, a distinct peptide.

2. The inventions are distinct, each from the other because of the following reasons:

The product of Invention I and the method of Invention II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product of Invention I can be used in an alternate method of use, e.g., as a detectable indicator bound to specific proteases in a process of purification of proteases.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by the different classification and the recognized divergent subject matter, and because Inventions I and II require different searches but are not co-extensive, examination of these distinct inventions would pose a serious burden on the examiner and therefore restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

A telephone call was made to Tom Hunter on November 5, 2001 to request an oral election to the above restriction requirement, but did not result in an election being made.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Min Kam whose telephone number is (703) 308-9437. The examiner can normally be reached on 8.00-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, Ph. D. can be reached on (703) 308-2923. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-0294 for regular communications and (703) 308-4227 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

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Chih-Min Kam, Ph. D.
Patent Examiner

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